



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,954	11/21/2001	Paul V. Morinville	IBIG1100-2	4408

42671 7590 05/03/2004

LAW OFFICES OF MARK L. BERRIER
1250 CAPITAL OF TEXAS HIGHWAY, SOUTH
BUILDING II, SUITE 216
AUSTIN, TX 78746

EXAMINER

RIMELL, SAMUEL G

ART UNIT	PAPER NUMBER
----------	--------------

2175

DATE MAILED: 05/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/990,954

Applicant(s)

MORINVILLE, PAUL V.

Examiner

Sam Rimell

Art Unit

2175

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

Art Unit: 2175

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3: The phrase “the business process” lacks antecedent basis.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Vora et al. (U.S. Patent 6,539,379).

Claim 1: FIG. 3C of Vora et al. discloses a hierarchical organizational chart. Specific individuals are arranged in a hierarchy based on their roles and responsibilities. Each individual represents a position in the hierarchy.

FIG. 5C provides a search report that identifies positions within the hierarchy of FIG. 3C. For example, “John Jackson—VP of Sales” is identified as a first position and “John Smith—President and CEO” is identified as a second position. According to the hierarchical structure of FIG. 3C, John Smith is above John Jackson. Thus, the output of FIG. 5C identifies first and second positions where the second position is above the first position.

In performing the records search that produces the search report of FIG. 5C, a determination must be made of the role associated with the second position since it must be printed in the search report. Thus, the role of “President and CEO” is determined by the computer system as being associated with John Smith (second position) as evidenced by the fact that it is printed next to John Smith in the search report. The term “selected role” is applicable to any role because the method of claim 1 does not call for a step of selecting anything. Thus, any role can be a “selected role”.

Parts (d)-(f) are conditional because they include the word “if” as a conditional statement. Since the steps (d)-(f) are conditional, they do not have to be performed. These steps thus do not carry patentable weight.

Claim 2: The “selected business process” can merely be the operation of the company. Performing a search for search results is part of the operation of the company. The identification of positions from search results would thus identify people who participate in operations of the company.

Claim 3: The search results identify selected roles. For example, in FIG. 5L, the selected role is engineering. If a search is performed for the employees in the role of engineering, the system determines all of the employees in that that perform that role (FIG. 5L). These employees are authorized to engage in the business process of engineering, which is the selected role.

Claim 4: The entire search template in FIG. 5J is readable as an approval matrix. The matrix allows a user to enter (identify) potential conditions (“skills” and “projects”) as well as roles (“title” or “organization”). The steps of determining the set of conditions is thus the step of

Art Unit: 2175

having the system read the data input into the search template and the step of selecting roles is the step of outputting a search set of search results, such as shown in FIG. 5L.

Claim 5: By applicant's definition in the disclosure, a "trip point" is pre-defined data indicating that a condition is met. Thus, in Vora et al., each one of entries in the matrix (available selections 164 in FIG. 5J) is a trip point, and selecting one of those entries is the action of triggering a trip point.

Claim 6: As seen in FIG. 5L, the role of "Engineering" is not unique to a single employee, and will involve multiple employees.

Claim 7: As seen in FIG. 5L, a selected role, such as "Engineering" can be associated with multiple unique positions, such as "V.P. Eng." "QA Manager" or "training associate".

Claim 8: A search of records for the term "Engineering" will involve searching the records of individuals who are below the second position ("President and CEO") in the organizational hierarchy. The "predetermined pattern" is the step of only searching for the term "Engineering" in the data records. However, any action of traversing data in a database reads as searching a "predetermined pattern", given that the pattern itself is not defined.

Claim 9: FIG. 3C illustrates a hierarchical organizational structure, which is a series of employee names arranged in a hierarchical organization. The roles associated with each name are also arranged in a hierarchy. Thus, FIG. 3C shows "John Smith" hierarchically above "Lou Reed" in the organizational hierarchy. FIG. 3C also shows the role of "President and CEO" hierarchically above the role of "CIO".

Claim 10-12: The hierarchical structure of FIG. 3C can be read as all three of the types of hierarchies defined in claims 10-12. It is functional role structure since the functions of each

Art Unit: 2175

position can be ascertained. For example, Robert Hughes functions as the head of the engineering department. It is a superiority role structure since certain employees are superior to others. For example, John Smith is superior to Robert Hughes. It is a “legal role” structure in that the hierarchy establishes who is employed by the overall organization. It is noted that the specification does not define what a “legal role structure” actually is, so this term is subject to interpretation.

Claim 13-15: FIG. 3C illustrates a hierarchy of jobs and a hierarchy of titles. FIG. 3E illustrates a subset of grades for certain titles. For example, the title of “Sales Manager” is associated with different grades, such as “Sales Manager of Japan”, “Sales Manager of Europe” etc.

Claim 16: FIG. 3E illustrates EEO classifications (employees such as John Jackson and Dave Gray are managers. The employee Robert Yates is a skilled professional).

Claim 17: FIGS. 3C and 3E illustrate job classifications.

Claim 18: The template of FIG. 5J permits the searching for any one of a wide variety of roles, such as managers for a particular employee, projects, skills, and job titles.

Claims 19-20: The search template of FIG. 5J can be used to perform a search for a first role, and then subsequently used to perform a search for a second role. A search for two different roles can be concurrently performed, such as when a user enters search criteria for both “skills” and “job title” at the same time and performs a query using both criteria.

Claim 21: FIG. 3C illustrates an organizational structure having a plurality of unique positions. A member of the organization (such as John Smith or Lou Reed) is associated with each position. The positions are arranged in a hierarchical structure. Each of the positions has a

Art Unit: 2175

role (such as VP of manufacturing or VP of marketing). As seen from FIG. 3C, the organization performs business functions (such as manufacturing, marketing, sales and engineering. Each individual has access rights to business processes. For example, Jane Paully and Jane Paully's subordinates have access to the business process of marketing by virtue of their association with the marketing department in the hierarchy.

Claims 22-23: See remarks for claims 10-12.

Claim 24: The approval matrix is the search template of FIG. 5J. The approval matrix can identify potential conditions ("skills" and "projects") and approval roles ("title" or "organization"). The system determines potential conditions by receiving the input of condition data ("skills" and "projects") and selects roles (specific individuals having specific roles) as seen in FIG. 5L. The display of those positions is an identification of the positions. Contacting the individuals in the identified roles by e-mail using the e-mail links in FIG. 5L reads as the step of obtaining approval. Note that the claim does not specify exactly what an approval is or what is being approved.

Claim 25: See remarks for claim 1.

Remarks

Applicant's arguments have been considered.

The previous grounds of rejection under 35 USC 112 is overcome by applicant's amendments. However, a new ground of rejection appears in claim 3 as a result of the amendment to claim 3. This ground of rejection can be resolved by changing "the business process" to "a business process".

Art Unit: 2175

The rejection of the independent claims 1 and 25 have been sustained in this action. In particular, applicant's amendments to the claims still leave significant portions of these claims as optional recitations. In particular, examiner maintains that parts (d)-(f) are entirely optional since the steps performed are prefaced by the word "if". Optional recitations are those which do not necessarily have to be performed, and thus carry no patentable weight (MPEP 2106, Section C).

Applicant has also presented arguments that the Vora et al. prior art does not disclose an approval matrix. While Examiner agrees that approval matrix of FIG. 7 in applicant's invention is not taught in the Vora et al. prior art, the description of the approval matrix in the claims does correspond to specific features of Vora et al. See examiner's remarks for claim 4 in particular in regards to how the claimed approval matrix corresponds to certain features in Vora et al.

This office action is made non-final.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (703) 306-5626.



Sam Rimell
Primary Examiner
Art Unit 2175